UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/809,586	03/25/2004	Joseph Won John	AUS920040008US1	7114

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INTERNATIONAL CORP (BLF)
c/o BIGGERS & OHANIAN, LLP
P.O. BOX 1469
AUSTIN, TX 78767-1469

EXAMINER
SHIU, HO T

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

	Application No.	Applicant(s)
Office Action Summary	10/809,586	JOHN, JOSEPH WON
	Examiner	Art Unit
	HO SHIU	2457

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>03 November 2008</u>.
2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.
3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1,3-9,11-17 and 19-24* is/are pending in the application.
    4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5)☐ Claim(s) _____ is/are allowed.
6)☒ Claim(s) *1, 3-9, 11-17, and 19-24* is/are rejected.
7)☐ Claim(s) _____ is/are objected to.
8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.
10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.
    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
    a)☐ All   b)☐ Some * c)☐ None of:
      1.☐ Certified copies of the priority documents have been received.
      2.☐ Certified copies of the priority documents have been received in Application No. _____ .
      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)
1)☒ Notice of References Cited (PTO-892)
2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3)☐ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date _____ .
4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____ .
5)☐ Notice of Informal Patent Application
6)☐ Other: _____ .

DETAILED ACTION

1.   In view of the appeal brief filed on 11/03/2008, PROSECUTION IS HEREBY

REOPENED. A new ground of rejection is set forth below.

To avoid abandonment of the application, appellant must exercise one of the

following two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply

under 37 CFR 1.113 (if this Office action is final); or,

(2) request reinstatement of the appeal.

If reinstatement of the appeal is requested, such request must be accompanied

by a supplemental appeal brief, but no new amendments, affidavits (37 CFR 1.130,

1.131 or 1.132) or other evidence are permitted. See 37 CFR 1.193(b)(2).

2.   Claims 1, 3-9, 11-17, and 19-24 are pending in this application.

Claim Rejections - 35 USC § 103

3.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
> the prior art are such that the subject matter as a whole would have been obvious at the time the
> invention was made to a person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was made.

4.   **Claims 1, 3-9, 11-17, and 19-24 are rejected under 35 U.S.C. 103(a) as being**

anticipated by Weatherby et al. (Pub # US 20004/0054741 A1, hereinafter

Weatherby) in view of Atkinson et al. (US Pub # 2004/0181571 A1, hereinafter

Atkin).

5.   With respect to claim 1, Weatherby discloses a method for establishing trust in

an email client, the method comprising: accepting in an email server a data

communications connection from an email client ([0029], lines 2-3), wherein the

connection includes the email client's network address ([0030], lines 1-4); determining

from a stored list of trusted network addresses whether the email client is trusted

according to the email client's network address ([0033], lines 1-6);

if the email client is not trusted according to the email client's network address, receiving

authentication data from the email client and determining whether the email client is

trusted according to the authentication data ([0015], lines 1-9); and

if the email client is not trusted according to the email client's network address and the

email client is not trusted according to the authentication data, receiving a sender

domain name for an email message from the email client and determining whether the

email client is trusted according to the sender domain name ([0030], lines 1-7) but does

not clearly disclose wherein determining whether the email client is trusted according to

the sender domain name further comprises requesting from a domain name service a

resource record of a type that lists for a sender domain network addresses of email

exchanges that are authorized to act as outbound email exchanges for the sender domain.

In the same field of endeavor, Atkinson discloses wherein determining whether the email client is trusted according to the sender domain name further comprises requesting from a domain name service a resource record of a type that lists for a sender domain network addresses of email exchanges that are authorized to act as outbound email exchanges for the sender domain ([0018], [0044], claim 28).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the teachings of Weatherby with the teachings of Atkinson in order to identify an actual sending side network address corresponding to a sending messaging server that sent the electronic message.

6.   With respect to claim 4, Weatherby discloses the email client is trusted according to the authentication data, and the method further comprises storing the email client's network address in association with a trust time limit in the list of trusted network addresses ([0040], lines 1-7).

7.   With respect to claim 5, Weatherby discloses accepting in the email server a connection from an email client requesting delivery of an email message ([0029], lines 2-3) according to a protocol that includes client authentication ([0031], lines 1-3, wherein the connection includes the network address of the email client requesting delivery of an email message ([0029], lines 4-6, lines 10-13);

authenticating the email client requesting delivery of an email message ([0030], lines 1-4, [0031], lines 1-3);

delivering the email message to the email client requesting delivery of an email message ([0030], lines 7-11); and

storing the network address of the email client requesting delivery of an email message in association with a trust time limit in the list of trusted network addresses ([0040], lines 1-7).

8.   With respect to claim 6, Weatherby discloses the email client is an email exchange that accepts outbound email messages only from trusted senders ([0033], lines 1-6).

9.   With respect to claim 7, Weatherby discloses receiving a sender domain name further comprises receiving the sender domain name in an SMTP MAILFROM message ([0029], lines 4-6).

10.   With respect to claim 8, Weatherby discloses the email client is not trusted according to the email client's network address, the email client is not trusted according to the authentication, the email client is not trusted according to the sender domain name, and the method further comprises sending an error message to the email client and closing the connection ([0030], lines 7-9, [0031], lines 1-3, lines 7-8).

11.   With respect to claim 9, Weatherby discloses a system for establishing trust in an

email client, the system comprising:

means for accepting in an email server a data communications connection from an

email client ([0029], lines 2-3), wherein the connection includes the email client's

network address ([0030], lines 1-4);

means for determining from a stored list of trusted network addresses whether the email

client is trusted according to the email client's network address ([0033], lines 1-6);

means for receiving authentication data from the email client and means for determining

whether the email client is trusted according to the authentication data if the email client

is not trusted according to the email client's network address ([0015), lines 1-9); and

means for receiving a sender domain name for an email message from the email client

and means for determining whether the email client is trusted according to the sender

domain name if the email client is not trusted according to the email client's network

address and the email client is not trusted according to the authentication data ([0030],

lines 1-7), but does not clearly disclose wherein means for determining whether the

email client is trusted according to the sender domain name further comprises means

for requesting from a domain name service a resource record of a type that lists for a

sender domain network addresses of email exchanges that are authorized to act as

outbound email exchanges for the sender domain.

In the same field of endeavor, Atkinson discloses wherein means for determining

whether the email client is trusted according to the sender domain name further

comprises means for requesting from a domain name service a resource record of a

type that lists for a sender domain network addresses of email exchanges that are

authorized to act as outbound email exchanges for the sender domain ([0018], [0044],

claim 28).

Therefore, it would have been obvious to a person of ordinary skill in the art at

the time the invention was made to modify the teachings of Weatherby with the

teachings of Atkinson in order to identify an actual sending side network address

corresponding to a sending messaging server that sent the electronic message.

12.   With respect to claim 12, Weatherby discloses the email client is trusted

according to the authentication data, and the system further comprises means for

storing the email client's network address in association with a trust time limit in the list

of trusted network addresses ([0040], lines 1-7).

13.   With respect to claim 13, Weatherby discloses means for accepting in the email

server a connection from an email client requesting delivery of an email message

([0029], lines 2-3) according to a protocol that includes client authentication ([0031],

lines 1-3, wherein the connection includes the network address of the email client

requesting delivery of an email message ([0029], lines 4-6, lines 10-13);

means for authenticating the email client requesting delivery of an email message

([0030], lines 1-4, [0031], lines 1-3);

means for delivering the email message to the email client requesting delivery of an

email message ([0030], lines 7-11); and

means for storing the network address of the email client requesting delivery of an email message in association with a trust time limit in the list of trusted network addresses ([0040], lines 1-7).

14.   With respect to claim 14, Weatherby discloses the email client is an email exchange that accepts outbound email messages only from trusted senders ([0033], lines 1-6).

15.   With respect to claim 15, Weatherby discloses means for receiving a sender domain name further comprises means for receiving the sender domain name in an SMTP MAILFROM message ([0029], lines 4-6).

16.   With respect to claim 16, Weatherby discloses means for sending an error message to the email client and means for closing the connection if the email client is not trusted according to the email client's network address, the email client is not trusted according to the authentication, and the email client is not trusted according to the sender domain name ([0030], lines 7-9, [0031], lines 1-3, lines 7-8).

17.   With respect to claim 17, Weatherby discloses a computer program product for establishing trust in an email client, the computer program product comprising: means, recorded on the recording medium ([0059], lines 9-14), for accepting in an email server

a data communications connection from an email client ([0029], lines 2-3), wherein the connection includes the email client's network address ([0030], lines 1-4);

means, recorded on the recording medium ([0059], lines 9-14), for determining from a stored list of trusted network addresses whether the email client is trusted according to the email client's network address ([0033] lines 1-6);

means, recorded on the recording medium ([0059], lines 9-14), for receiving authentication data from the email client and means, recorded on the recording medium, for determining whether the email client is trusted according to the authentication data if the email client is not trusted according to the email client's network address ([0015], lines 1-7);   and

means, recorded on the recording medium ([0059], lines 9-14), for receiving a sender domain name for an email message from the email client and means, recorded on the recording medium, for determining whether the email client is trusted according to the sender domain name if the email client is not trusted according to the email client's network address and the email client is not trusted according to the authentication data ([0030], lines 1-7), but does not clearly disclose wherein means, recorded on the recording medium, for determining whether the email client is trusted according to the sender domain name further comprises means, recorded on the recording medium, for requesting from a domain name service a resource record of a type that lists for a sender domain network addresses of email exchanges that are authorized to act as outbound email exchanges for the sender domain.

In the same field of endeavor, Atkinson discloses wherein means, recorded on the recording medium, for determining whether the email client is trusted according to the sender domain name further comprises means, recorded on the recording medium, for requesting from a domain name service a resource record of a type that lists for a sender domain network addresses of email exchanges that are authorized to act as outbound email exchanges for the sender domain ([0018], [0044], claim 28).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the teachings of Weatherby with the teachings of Atkinson in order to identify an actual sending side network address corresponding to a sending messaging server that sent the electronic message.

18.   With respect to claims 3, 11, and 19, it is rejected for the same reasons as claims 1, 9, and 17 above. In addition, Atkin discloses the method step, means for, and computer program product recorded on the recording medium for determining whether the e-mail client is trusted according to the sender domain name further comprises determining whether a domain name service resource record associates the email client's network address with the sender domain name and lists for a sender domain network addresses of email exchanges that are authorized to act as outbound email exchanges for the sender domain name, the DNS resource record being of a type that lists for a sender domain network addresses of email exchanges that are authorized to act as outbound email exchanges for the sender domain ([0018], [0044], claim 28).

19.   With respect to claim 19, it is rejected for the same reasons as claim 17 above.

In addition, Atkin discloses the method step, means for, and computer program product

recorded on the recording medium for determining whether the e-mail client is trusted

according to the sender domain name further comprises determining whether a domain

name service resource record associates the email client's network address with the

sender domain name and lists for a sender domain network addresses of email

exchanges that are authorized to act as outbound email exchanges for the sender

domain name, the DNS resource record being of a type that lists for a sender domain

network addresses of email exchanges that are authorized to act as outbound email

exchanges for the sender domain ([0018], [0044], claim 28).

20.   With respect to claim 20, Weatherby discloses the email client is trusted

according to the authentication data, and the computer program product further

comprises means, recorded on the recording medium , for storing the email client's

network address in association with a trust time limit in the list of trusted network

addresses ([0040], lines 1-7).

21.   With respect to claim 21, Weatherby discloses means, recorded on the recording

medium, for accepting in the email server a connection from an email client requesting

delivery of an email message ([0029], lines 2-3) according to a protocol that includes

client authentication ([0031], lines 1-3), wherein the connection includes the network

address of the email client requesting delivery of an email message ([0029], lines 4-6,

lines 10-13);

means, recorded on the recording medium, for authenticating the email client requesting

delivery of an email message ([0030], lines 1-4, [0031], lines 1-3);

means, recorded on the recording medium, for delivering the email message to the

email client requesting delivery of an email message ([0030], lines 7-11); and

means, recorded on the recording medium, for storing the network address of the email

client requesting delivery of an email message in association with a trust time limit in the

list of trusted network addresses ([0040], lines 1-7).

22.   With respect to claim 22, Weatherby discloses the email client is an email

exchange that accepts outbound email messages only from trusted senders ([0033],

lines 1-6).

23.   With respect to claim 23, Weatherby discloses means, recorded on the

recording medium, for receiving a sender domain name further comprises means,

recorded on the recording medium, for receiving the sender domain name in an SMTP

MAILFROM message ([0029], lines 4-6).

24.   With respect to claim 24, Weatherby discloses means, recorded on the recording

medium, for sending an error message to the email client and means, recorded on the

recording medium, for closing the connection if the email client is not trusted according

to the email client's network address, the email client is not trusted according to the

authentication, and the email client is not trusted according to the sender domain name

([003], lines 7-9, [0031], lines 1-3, lines 7-8).

Claim Rejections - 35 USC § 103

25.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
> the prior art are such that the subject matter as a whole would have been obvious at the time the
> invention was made to a person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was made.

26.   Claims 3, 11, and 19 are rejected under 35 U.S.C. 103(a) as being

unpatentable over Weatherby and Atkin as applied to claims 1, 9, and 17 in view

of Lalonde et al. (US Pub # 2004/0068542 A1, hereinafter Lalonde).

27.   With respect to claims 3, 11, and 19, Weatherby and Atkin discloses the method

step, means for, and computer program product recorded on the recording medium for

determining whether the e-mail client is trusted according to the sender domain name

further comprises determining whether a domain name service resource record

associates the email client's network address with the sender domain name and lists for

a sender domain network addresses of email exchanges that are authorized to act as

outbound email exchanges for the sender domain (Weatherby, [0030], lines 1-7, [0041],

lines 10-18) (Atkin ([0018], [0044], claim 28), the DNS resource record being of a type

that lists for a sender domain network addresses of email exchanges that are

authorized to act as outbound email exchanges for the sender domain (Atkin [0018],

[0044], claim 28).

In the same field of endeavor, Lalonde also discloses the DNS resource record

being of a type that lists for a sender domain network addresses of email exchanges

that are authorized to act as outbound email exchanges for the sender domain ([0039],

lines 8-13).

Therefore, it would have been obvious to a person of ordinary skill in the art at

the time the invention was made to modify the teachings of Weatherby and Atkin with

the teachings of Lalonde in order to extract the IP address from the server domain

name and vice versa.

Response to Arguments

28.   Applicant's arguments with regard to claims 1, 3-9, 11-17, and 19-24 have been

fully considered but are moot in view of new grounds of rejection.

Conclusion

29.   The examiner notes that the applicant's claimed invention focuses on a method

wherein a first user account comprises an undesirable receiving device that holds

undesirable messages which the first user cannot access, and a second user account

that is used to access these undesirable messages addressed to the first user.

30.   Any inquiry concerning this communication or earlier communications from the

examiner should be directed to HO SHIU whose telephone number is (571)270-3810.

The examiner can normally be reached on Mon-Thur (8:30am - 4:00pm).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Ario Etienne can be reached on 571-272-4001. The fax phone number for

the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the

Patent Application Information Retrieval (PAIR) system. Status information for

published applications may be obtained from either Private PAIR or Public PAIR.

Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see http://pair-direct.uspto.gov. Should

you have questions on access to the Private PAIR system, contact the Electronic

Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a

USPTO Customer Service Representative or access to the automated information

system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

HTS   Ho Ting Shiu
01/30/2009   Patent Examiner
                                                             GAU 2457

/ARIO ETIENNE/

Supervisory Patent Examiner, Art Unit 2457